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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,234	10/20/2003	Charles DeGennaro JR.	3006.1001	4075
41226	7590	06/04/2007		
POLLACK, P.C. THE CHRYSLER BUILDING 132 EAST 43RD STREET, SUITE 760 NEW YORK, NY 10017			EXAMINER PIERCE, WILLIAM M	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 06/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/689,234

Applicant(s)

DEGENNARO, CHARLES

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). As set forth in the previous office action. While applicant submitted new drawings 7 and 8, these figures are blank and void of any meaningful text. As such they do not overcome this objection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action.

"One of the subject matters courts have found to be outside the four statutory categories of invention is abstract ideas. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939).

The instant claims fail to recite any physical structure or a sequence of physical steps that can be performed."

Applicant argues that claims 34-26 "relates to steps performed". While this may be true, these steps are not positively recited. For example, claim 24 recites that the flexible wire is "operable to be folded" then recites "wherein at least one a player chooses..." which is a functional statement and not a positive step. While steps of folding, choosing and shaping could be steps of the claim, these are not positively recited. A method or process only covers the steps recited and none are positively recited in claims 24-26.

### ***Claim Rejections - 35 USC § 112***

Claims 1-11, 13, 14, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

Art Unit: 3711

subject matter which applicant regards as the invention as set forth in the previous office action.

"One cannot determine if claims 1-11 are directed to a method or an apparatus. Since the remaining claims recite a method, for the purposes of this office action they are being treated as intended on being drawn to an apparatus.

Claims 13, 14, 22 and 23 recites rules and fails to set forth any further physical steps to be performed in the process of the game and is held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986)."

As to claims 1-11, while applicant has amended to read "a game system", such does not overcome this rejection. As "system" can be a method or an apparatus.

With respect to claims 13, 14, 22 and 24, applicant states that they recite "an optional step of the method of practicing the game". However, they do not and that is the basis for this grounds for rejection. At best these recitations set forth rules. But rules do not set for positive action steps that one can perform that would further limit the claimed invention.

### ***Claim Rejections - 35 USC § 103***

Claims 1-10, 12-15 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over What is Claymania in view of Wire Sculpture as set forth in the previous office action.

"As to claims 1-3, 5-10, 12, 15 and 20-25, Claymania shows making a sculpture conforming to indicia on cards out of clay within a given amount of time. While the use of wire is not discussed, the prior art teaches that wire is a well known media for making a sculpture. To have replaced the clay of Claymania with wire would have been an obvious matter of choosing one known media for that of another. Applicant has not shown his choice of media to be critical by solving any particular problem or producing any unexpected results. As to claim 4, providing individual color coded game paraphernalia to player is old and well known. As to claims 7, 19 and 25, having cards categorized to different levels of difficulty is know in question and answer type games.

Art Unit: 3711

Claims 13, 14, 22 and 23 reflect only rules of play that are analogous to functional limitations in an apparatus claim in that they fail to further limit the claim by reciting a positive physical step that can be performed. As such recitation fail to distinguish over the art of record. Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph as set forth above."

While applicant remarks that his game is "entirely different" from Claymania, the examiner does not agree for the reasons and motivation set forth above. The ability to make shapes of both clay and wire are considered fairly taught in the art. Likewise the use or not allowing the use of body language in such a game (such as charades) is not something that was invented by applicant and is fairly taught by the art as a whole.

Claims 11, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claymania in view of Wire Sculpture in view of Cohen as set forth in the previous office action.

"In Claymania, prevailing players are recorded by being awarded a token that marks a space. However, Cohen teaches that it is known in question and answer type games to have moves being awarded for correct answers to the cards and die and spinners are well known equivalents with respect to random number generators. To have recorded the prevailing game events of Claymania with a spinner that awarded advancement of a players playing piece would have been obvious in order to record game events of a player."

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3711

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE  
PRIMARY EXAMINER